



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,461	02/17/1999	FRANCIS THOMAS BOYLE	07164.0010	1092

22852 7590 12/27/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 12/27/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/242,461

Applicant(s)

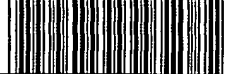
BOYLE et al.

Examiner

Brenda Coleman

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 21, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 13, and 18-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9, 13, and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1624

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application.

Claims 7-9, 13 and 18-22 are pending in the application.

This action is in response to applicants' amendment dated October 21, 2002. Claims 1, 3, 10-12 and 14-17 were canceled, claims 7-9 and 12 were amended and claims 18-22 are newly added.

Response to Arguments

Applicant's arguments filed October 21, 2002 have been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the improper Markush rejection of the last office action, which is hereby **withdrawn**.
2. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejections of the last office action, which are hereby **withdrawn**.
3. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of the last office action, which are hereby **withdrawn**.
4. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of the last office action, which is hereby **withdrawn**.

Art Unit: 1624

In view of the amendment dated October 21, 2002, the following new grounds of rejection apply:

Specification

5. The disclosure is objected to because of the following informalities:
 - a) The amendment to the specification spanning page 2, line 7 to page 4, line 9 contains a typographical error, i.e. the definition of T where T is $-(CH_2)_m-$ is not a subscript. See line 8 on page 4 of the amendment.
 - b) The amendment to the specification spanning page 2, line 7 to page 4, line 9 contains a typographical error, i.e. the definition of T where T is $-(CH_2)_m^1-$ is not a subscript. See line 10 on page 4 of the amendment.
 - c) The amendment to the specification spanning page 4, line 10 to page 6, line 11 contains a typographical error, i.e. the definition of R^{14} where R^{14} is \underline{N} -(diC1-4alkyl)carbamoylC₁₋₄alkyl is not a subscript. See lines 1-2 on page 6 of the amendment.
 - d) The amendment to the specification spanning page 4, line 10 to page 6, line 11 contains a typographical error, i.e. the definition of T where T is $-(CH^2)_w-$. It is believed that this should be $-(CH_2)_n-$. See line 1 on page 7 of the amendment.
 - e) The amendment to the specification spanning page 10, line 4 to page 10, line 15 contains a typographical error, i.e. the definition of G where $G=CHNR^{16}T$. It is

Art Unit: 1624

believed that this should be $G = \text{CH}_2\text{NR}^{16}\text{T}$. See line 12 on page 8 of the amendment.

- f) The amendment to the specification spanning page 10, line 20 to page 10, line 22 contains a typographical error, i.e. the definition of G where G is $-\text{CH}_2\text{NH}_2-$. It is believed that this should be $-\text{CH}_2\text{NH}-$. See line 7 on page 9 of the amendment.
- g) The amendment to the specification spanning page 10, line 23 to page 10, line 26 contains a typographical error, i.e. the definition of G where G is $-\text{CH}_2\text{NR}^{16}\text{-T}$. The R16 is not a superscript. See line 10 on page 9 of the amendment.
- h) The amendment to the specification spanning page 32, line 4 to page 32, line 24 contains a typographical error, i.e. the use of DCI/HOBT. The specification was amended from DCCI/HOBT. Clarification is requested. See line 5 on page 15 of the amendment.
- i) The amendment to the specification spanning page 32, line 24 to page 33, line 3 contains a typographical error, i.e. the Ue of an organic base. It is believed this should be Use. See line 3 on page 16 of the amendment.
- j) The amendment to the specification spanning page 33, line 13 to page 33, line 18 contains a typographical error, i.e. the definition of G where G is $-\text{CH}_2\text{NR}^{16}-$. It is believed that the hyphen after the subscript 2 should not be a subscript. See line 1 on page 17 of the amendment.

Art Unit: 1624

- k) The amendment to the specification spanning page 33, line 28 to page 34, line 2 contains a typographical error, i.e. the definition of G where G is $-\text{CH}_2\text{NR}^{16}\text{-T-}$, $-\text{CH}_2\text{O-T-}$, $-\text{CH}_2\text{S-T-}$. It is believed that the hyphen after the subscript 2 should not be a subscript. See lines 9-10 on page 17 of the amendment.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 8, 9 and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the nomenclature of the species in claim 8 is not described in the specification, i.e. (2S)-2-(2-methoxyethyl)-1-((cis)-3-sulfanyl-pyrrolidin-2-ylmethyl)-4-naphthoyl-piperazine.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1624

7. Claims 7, 9, 13 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

- a) Claims 7, 9, 13 and 18-22 are vague and indefinite in that it is not known what is meant by the "t" in the definition of the substituents on the aryl or heterocycle of R^2 , R^3 , R^4 , and R^5 . It is believed that the applicants intended a subscript.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays from 8:30 AM to 5:00 PM, on Tuesdays from 8:00 AM to 4:30 PM, on Wednesday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
December 24, 2002